

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)
Yukihiko TAGUCHI) Examiner Leonard J. WEINSTEIN
Application No.: 10/510,342) Group Art Unit 3746
Filed: October 5, 2004) Confirmation No. 8373
For: VARIABLE DISPLACEMENT)
COMPRESSOR)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant is submitting the following remarks with a Pre-Appeal Brief Request for Review in accordance with the Official Gazette Notice of July 12, 2005, and the Extension of Pre-Appeal Brief Conference Program, dated January 10, 2006. Applicant respectfully requests that the Panel of Examiners (the "Panel") reconsider the above-captioned patent application in view of the following remarks.

Remarks:

1. Rejections

Claims 1-5 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by Patent No. US 6,481,976 B2 to Kimura *et al.* ("Kimura") in view of U.S. Patent No. 5,332,365 to Taguchi ("Taguchi '365"). Applicant respectfully disagrees.

2. 35 U.S.C. § 103(a)

Claims 1-5 stand rejected as allegedly rendered obvious by Kimura in view of Taguchi. In order for the Office Action to establish a prima facie case of obviousness, at least three criteria must be met. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as proposed by the Office Action. Second, there must be a reasonable expectation of success. Third, the prior art references must disclose or suggest all the claim limitations. MPEP 2143. For the reasons set forth below, Applicant respectfully submits that the Office Action fails to establish a prima facie case of obviousness.

Applicant's independent claim 1 recites, in part: "a partition wall disposed around said valve element, . . . [and] a pressure chamber which partitioned from said valve chamber by said partition wall. . . whereby a gap is defined between said partition wall and said valve element for forming a non-contact structure."

a. Office Action Mailed September 5, 2008

The Office Action mailed September 5, 2008, asserted that Kimura discloses each and every limitation of independent claim 1, except that the pressure chamber is partitioned from the valve chamber by the partition wall. Nevertheless, the Office Action asserted that Taguchi discloses this missing limitation, and that it would have been obvious at the time of the invention to modify Kimura in view of Taguchi to achieve Applicant's claimed invention. Specifically, the Office Action asserted that Kimura discloses a partition wall 59 which does not contact a valve element 43. The Office Action also asserted that Taguchi discloses that a pressure chamber is partitioned from a valve chamber by a fixed partition wall 482.

The Office Action acknowledged that partition wall 482 contacts a valve element 481. Nevertheless, the Office Action asserted that if Kimura were modified to include partition wall 482 of Taguchi, it would have been obvious to have partition wall 482 not contact valve element 43 because partition wall 59 does not contact valve element 43, and it would not be necessary for partition wall 482 support valve element 43 because other elements already support valve element 43. Applicant disagreed with the Office Action's assertions.

In response to the Office Action, Applicant argued that the Office Action failed to provide an apparent reason as to why one of ordinary skill in the art at the time of the invention would have been motivated to modify Kimura to include partition wall 482 of Taguchi if partition wall 482 would not support (contact) valve element 43 of Kimura in such a modification. Specifically, partition wall 59 of Kimura already includes passage 58 formed

therethrough. The mere fact that a reference can be modified in of itself is insufficient to establish a prima facie case of obviousness, and the Office Action must establish why one of ordinary skill in the art would have been motivated to make the proposed modification. See, e.g., MPEP 2143.01 (III). In contrast, the Office Action merely asserted that Kimura could be modified to include partition wall 482 of Taguchi and to have partition wall 482 not contact valve element 43 of Kimura, however, the Office Action did not provide an apparent reason as to why one of ordinary skill in the art would be motivated to make such a modification.

b. Advisory Action Mailed November 4, 2008

In response to Applicant's remarks set forth above, which Applicant presented in response to the Office Action mailed May 5, 2008, the Advisory Action asserts that the valve seat of Kimura serves the same function as the "non-contact" partition wall described in independent claim 1. The Advisory Action argues that the valve seat of Kimura is similar to the "non-contacting" feature of the partition wall disclosed in independent claim 1 because the valve seat of Kimura does not contact the valve element. The Advisory Action acknowledges that the valve seat of Kimura does not form a partition wall that partitions a pressure chamber from a valve chamber. Nevertheless, the Advisory Action asserts that Taguchi discloses a partition plate that partitions a valve chamber. The Advisory Action then maintains that a person with ordinary skill in the art would have found it obvious to substitute the partition plate of Taguchi for the valve seat of Kimura to form a "non-contact" partition wall to achieve Applicant's claimed invention. Specifically, the Advisory Action asserts that Taguchi "represents evidence that an inwardly extending wall having a hole through which fluid can flow was an art-recognized equivalent structure for a valve seat that forms a passage through which fluid can flow when a plunger is not resting on the valve seat." See, Advisory Action, Page 3, Lines 38-40. Applicant respectfully disagrees with the Advisory Action's assertions.

For example, contrary to the Advisory Action's assertions, substituting the partition plate of Taguchi for the valve seat of Kimura does not result in the "non-contacting" partition wall, as described in independent claim 1. Specifically, the partition plate of Taguchi is coupled to the valve element. Thus, substituting the partition plate of Taguchi for the valve seat

of Kimura results in a partition wall that contacts the valve element rather than a “non-contacting” partition wall, as described in independent claim 1.

The Advisory Action asserts that when the valve seat of Kimura is replaced by the partition plate of Taguchi, the gap between the valve seat of Kimura and the valve element of Kimura is maintained with respect to the partition plate of Taguchi and the valve element of Kimura. Nevertheless, even assuming Arguendo that the valve seat of Kimura and the partition plate of Taguchi are recognized in the art as “equivalent structures,” and that because the valve seat of Kimura and the partition plate of Taguchi are equivalent structures there is an apparent reason to replace the valve seat of Kimura with the partition plate of Taguchi, the Advisory Action still has not provided an apparent reason why such a gap would be maintained when the valve seat of Kimura is replaced by the partition wall of Taguchi. In contrast, Applicant respectfully submits that if the valve seat of Kimura and the partition plate of Taguchi are indeed equivalent structures, then the Advisory Action must replace all of the features associated with the valve seat of Kimura with the partition plate of Taguchi. One of the features of the partition wall of Taguchi is that it contacts the valve element. To replace the valve seat of Kimura with the partition plate of Taguchi, but to not have the partition wall of Taguchi contact the valve element of Kimura, corresponds to impermissible hindsight by selecting merely some of the features of the partition plate of Taguchi and combining those elements with merely some of the features of the valve seat of Kimura. Nevertheless, the combination of Kimura and Taguchi does not disclose or suggest such a combination of elements, and such a combination only may be achieved in view of Applicant’s disclosure. Therefore, Applicant respectfully requests that the Panel withdraw the obviousness rejection of independent claim 1 at least for these reasons.

Claims 2-5 depend from allowable, independent claim 1. Therefore, Applicant respectfully requests that the Panel also withdraw the obviousness rejection of claims 2-5 at least for this reason.

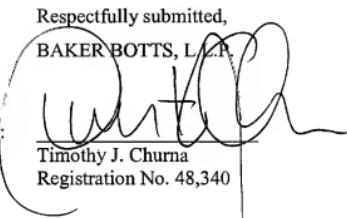
Conclusion:

Applicant respectfully submits that the above-captioned patent application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution of this application may be furthered by discussing the application, in person or by telephone, with Applicant's representative, Applicant would welcome the opportunity to do so. Applicant believes that no fees are due as a result of this submission. Nevertheless, in the event of any variance between the fees determined by Applicant and the fees determined by the PTO, please charge or credit any such variance to the undersigned's **Deposit Account No. 02-0375.**

Date: **December 5, 2008**

Baker Botts, L.L.P.
The Warner
1299 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2400
Tel.: (202) 639-7700
Fax: (202) 639-7890

JBA/TJC/tt

Respectfully submitted,

BAKER BOTTS, L.L.P.
By: _____
Timothy J. Churna
Registration No. 48,340